

## **Remarks**

### Amendments to the Claims

The amendments to the claims do not add new matter. Claim 3 is canceled. Claims 1 and 2 are amended to further define the GPR14 polypeptide. This amendment is supported on page 5, lines 1-11 of the specification. Claims 1 and 2 are amended to recite particular types of cancers in the preamble and to include a step of determining if the test compound has an effect on a symptom of the cancer in an *in vivo* assay. The recited cancers are disclosed on pages 65-67 and in Example 2, which begins on page 88. *In vivo* assay testing is disclosed on page 39, lines 23-26 and page 40, lines 9-13. Claim 2 is amended to recite activities of the GPR14 polypeptide. The recited activities are disclosed on page 48, line 20 to page 49, line 30 and on page 102, lines 20-24.

### Objection to the Claims

Claims 1-3 are objected to because they recite non-elected disease species. Claim 3 is canceled. To advance prosecution, claims 1 and 2 are amended to delete the non-elected species. Please withdraw the objection.

### Rejection of Claims 1-11 Under 35 U.S.C. § 112 ¶ 1

Claims 1-11 are rejected under 35 U.S.C. § 112 ¶ 1 as failing to comply with the written description requirement with respect to the recited GPR14 polypeptide. Claim 3 is canceled. To advance prosecution, claims 1 and 2 are amended to further define the GPR14 polypeptide. The amendment is fully supported in the specification (page 5, lines 1-11). Example 11 (“Percent Identity”) of the PTO’s Written Description Training Materials explains that with the help of a

computer, one of skill in the art can identify “all of the nucleic acids that encode a polypeptide with at least 85% sequence identity with SEQ ID NO:2 [an amino acid sequence].” By necessity, then, one of skill in the art would also be able to identify all the polypeptides with at least 85% sequence identity with SEQ ID NO:2.

Claims 1, 2, and 4-11 as amended satisfy the written description requirement of 35 U.S.C. § 112 ¶ 1. Please withdraw the rejection.

Rejection Under 35 U.S.C. § 112 ¶ 2

Claims 1-3 are rejected as indefinite under 35 U.S.C. § 112 ¶ 2. First, the Office Action asserts the acronym “GPR14” is indefinite. As discussed above, claim 3 is canceled, and claims 1 and 2 are amended to further define the recited GPR14 polypeptide.

Second, the Office Action asserts it is unclear what activity is recited in claims 2 and 3. Claim 3 is canceled. Claim 2 is amended to recite activities of the GPR14 polypeptide.

Finally, on page 5 the Office Action asserts that claims 1-3 are indefinite because “the methods do not necessarily achieve the goal set forth in the claim preamble.” Claim 3 is canceled. Claims 1 and 2 are amended to recite particular cancers in the preamble and to include a step of determining if the test compound has an effect on a symptom of any of several recited cancers in an *in vivo* assay.

Claims 1 and 2 as amended are definite. Please withdraw the rejection.

Rejection Under 35 U.S.C. § 102(b)

Claims 1-11 are rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent 6,159,700. Claim 3 is canceled. Independent claims 1 and 2 are amended to recite particular cancers and a step of determining if the test compound has an effect on a symptom of any of several recited cancers in an *in vivo* assay. The '700 patent does not disclose this subject matter.

Please withdraw the rejection.

Respectfully submitted,

**BANNER & WITCOFF, LTD.**

/Lisa M. Hemmendinger/

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By: \_\_\_\_\_

Lisa M. Hemmendinger  
Registration No. 42,653

Customer Number: 22907

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